

## REMARKS

In the Office Action of August 31, 2004, claims 1, 9, 14 and 15 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, the Office Action requested that the words "the severed web to" be inserted after the word "supplying" in claim 1 in order to provide for clarity and/or definiteness. Applicants respectfully submit that claims 1, 9, 14 and 15 do not suffer from any §112 deficiencies in that the claims are sufficiently clear and definite for purposes of §112. However, in order to further prosecution of the case and in order to ensure that no possible confusion exists regarding the wording of claims 1, 9, 14 and 15, Applicants are herein amending the stated claims as suggested in the Office Action. As such, Applicants respectfully request the §112 rejection be removed from claims 1, 9, 14 and 15.

Also, in the Office Action, claims 1-6 and 8-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Butterworth, et al (U.S. Patent No. 5,226,611) in view of Perini (U. S. Patent No. 4,487,377).

Applicants respectfully traverse the §103(a) rejection to claims 1-6 and 8-22 over Butterworth in view of Perini. Respectfully, it would not have been obvious for one having ordinary skill in the art to modify Butterworth in view of Perini so that the resulting device includes a rotating transfer roll that is configured for supplying the severed web to a single winding roll during rotation of the rotating transfer roll as set forth in claim 1 of Applicants' application.

In order to establish a case of *prima facie* obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. If the proposed modification or combination would render

the reference being modified unsatisfactory for its intended purpose, then there can be no suggestion or motivation to make the proposed modification or combination. In the present case, modification of Butterworth in view of Perini would render Butterworth unsatisfactory for its intended purpose and as such a case of *prima facie* obviousness cannot be made.

The title of Butterworth is "Twin Station Rewinder." The twin station rewinder of Butterworth is used to rewind a web of paper into paper "logs" that are preferably relatively small diameter rolls of paper so as to be suitable for consumer use (see Butterworth at column 1, lines 6-11). Butterworth describes prior art rewinders and indicates that these systems use a single winding station 4 (see Butterworth at column 1, lines 12-13). Butterworth explicitly states that a single winding station 4 is not preferred because the core will be moved first through a nip between two rolls into a position where the core is held between three rolls and finally removed therefrom between two of the three rolls before completion of the winding cycle (see Butterworth at column 1, lines 14-19). Butterworth also explicitly states that it has been found that transferring the log from two roll to three roll contact and then back to a two roll contact causes discontinuities in the winding process that result in deficiencies in the product quality of logs wound by a single rewinder (see Butterworth at column 1, lines 19-24). Butterworth seeks to overcome the shortcomings of prior rewinders that employ only a single winding station by providing for a twin station rewinder that employs uninterrupted three roll contact that is said to "substantially improve" product quality in the finished wound log (see Butterworth at column 1, lines 25-29).

The twin station rewinder of Butterworth employs a first rewinder station 47 that may be in the process of building a log while a second rewinder station 46 is supplied

with a new core (see Butterworth at column 2, lines 36-38). Use of a pair of rewinding stations allows a log to be wound at one station while the other station discharges a completed log and receives a new core for winding a subsequent log (see Butterworth at column 3, lines 52-55). The web 16 is alternated between winding stations 46 and 47 at the completion of each log so as to provide for a smooth, controlled, adjustable transition from one log to the next with consistent web tension throughout the winding cycle and without stopping the web (see Butterworth at column 3, lines 55-60). It is therefore the case that Butterworth is explicitly directed towards an improved rewinder that employs a pair of rewinding stations 46, 47 so as to avoid the disadvantages stated in Butterworth of prior rewinding stations that employ only a single winding station.

The intended purpose of Butterworth is to provide for a pair of rewinding stations 46, 47 so as to provide for improved rewinding and to “substantially improve” product quality. Modifying Butterworth in view of Perini so that only a single winding station exists would entirely frustrate the intended purpose of Butterworth and would render Butterworth unsatisfactory for its intended purpose. As such, there is no suggestion or motivation to make the modification or combination proposed in the Office Action of August 31, 2004.

Additionally, if the proposed modification or combination of the references would change the principle of operation of the reference being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. The principle of operation in Butterworth is to employ dual rewinding stations 46, 47 so that the logs enjoy uninterrupted three roll contact so as to enjoy increased product quality. Removing one of the rewinding stations 46 or 47 in view of Perini would result in a modified rewinder that would not be capable of having uninterrupted three roll contact.

Therefore, since the proposed modification or combination of references would change the principle of operation of Butterworth, then the teachings of the references are not sufficient to render claim 1 of Applicants' application *prima facie* obvious.

References can be modified or combined with one another to reject claims as being *prima facie* obvious as long as there is a reasonable expectation of success. Here, Butterworth explicitly states that a use of a pair of rewinding stations 46, 47 allows for a smooth, controlled, adjustable transition between the building of each log along with consistent web tension throughout the winding cycle and continual running of the web (see Butterworth at column 3, lines 55-60). Further, Butterworth explicitly states that the use of a single winding station 4 causes discontinuities in the winding process that result in deficiencies in product quality (see Butterworth at column 1, lines 19-24). As such, if one were to modify Butterworth in view of Perini so as to remove one of the winding stations 46 or 47, one would not have a reasonable expectation of success in the resulting apparatus because Butterworth explicitly states that rewinders with a single winding station are problematic and that rewinders with a pair of rewinding stations are beneficial. If a reference explicitly states that a particular modification would result in a less desirable product, there cannot possibly be a reasonable expectation of success when one seeks to make the stated modification. As such, Applicants respectfully submit that a case of *prima facie* obviousness has not been met because a reasonable expectation of success in the modification or combination does not exist.

To support the conclusion that claim 1 of Applicants' application is directed to obvious subject matter, the references must expressly or impliedly suggest the apparatus of claim 1 or the Office Action must present a convincing line of reasoning as to why the artesian would have found the apparatus of claim 1 to have been obvious in

the light of the teachings in the references. As stated, the combination of Butterworth and Perini does not expressly or impliedly suggest the apparatus as set forth in claim 1 of Applicants' application because Butterworth expressly teaches towards a pair of rewinding stations 46 and 47 in view of Perini. The Office Action of August 31, 2004 states in the first and third full paragraphs on page 3 that one having ordinary skill in the art would be able to "configure the apparatus of Butterworth, et al. for operation on one winding station as shown by Perini, if a second winding station is not desired."

Applicants respectfully submit that a convincing line of reasoning as to why one having ordinary skill in the art would have modified Butterworth in view of Perini has not been shown. Specifically, a convincing line of reasoning has not been presented as to why one having ordinary skill in the art would remove one of the winding stations 46 or 47 of Butterworth in view of Perini especially considering the fact that Butterworth is specifically directed towards an apparatus that employs a pair of rewinding stations 46 and 47. Additionally, a convincing line of reasoning has not been presented to address the fact that Butterworth expressly states that a rewinder with two winding stations 46 and 47 is advantageous over designs employing a single winding station and expressly states that the invention of Butterworth is made so as to overcome shortcomings of prior rewinders that employ only a single winding station.

Therefore, Applicants respectfully submit that it would not have been obvious for one having ordinary skill in the art to modify Butterworth in view of Perini in order to achieve the apparatus as set forth in claim 1 of Applicants' application. Applicants respectfully submit that claim 1 is not obvious over Butterworth in view of Perini and is in condition for allowance. Further, all claims that depend from claim 1 (claims 2-6 and 8)

are also in condition for allowance. The rejections to claims 2-6 and 8 are made moot due to the allowance of claim 1.

The rest of the independent claims in Applicants' application (claims 9, 14 and 15) also call for either an apparatus or a method that employs a rotating transfer roll that supplies the severed web to a single winding roll. As such, Applicants respectfully submit that the independent claims 9, 14 and 15 are not obvious over Butterworth in view Perini for essentially the same reasons as discussed above with respect to claim 1 and are in condition for allowance. Additionally, all claims that depend from independent claims 9 and 15 (claims 10-13 and 16-22) are also in condition for allowance as their rejections are made moot due to the allowance of independent claims 9 and 15.

Applicants respectfully submit that all claims are allowable and that the application is in condition for allowance. Favorable action thereon is respectfully requested. The Examiner is encouraged to contact the undersigned at his convenience to resolve any remaining issues.

Respectfully submitted,

DORITY & MANNING, P.A.

November 29, 2004  
Date

Neal P. Pierotti  
Neal P. Pierotti  
Reg. No. 45,716  
P.O. Box 1449  
Greenville, SC 29602-1449  
(864) 271-1592  
FAX (864) 233-7342